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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,659	09/30/1999	FUJIO OKADA	0250-776	5699

27383 7590 06/01/2004

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EXAMINER

MISLEH, JUSTIN P

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 06/01/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/409,659

Applicant(s)

OKADA ET AL.

Examiner

Justin P Misleh

Art Unit

2612

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1 - 5.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Wendy R. Garber
WENDY R. GARB
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Continuation of 5. does NOT place the application in condition for allowance because:

In the Final Office Action (Paper No. 11, 15 January 2004), Claims 1, 2, 4/1, 4/2, 5/1, and 5/2 were rejected under 35 U.S.C. 102(e) as being anticipated by Yamanaka et al. (US 6,078,353). The Applicant claims Yamanaka et al. does not qualify as prior art.

35 U.S.C. 102(e) states:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The Yamanaka et al. reference was filed in the United States on 11 September 1997 by Kazuhiro Yamanaka and Mitsuru Higuchi and is owned by the Fuji Photo Optical Co., Ltd.

The present application was filed in the United States on 30 September 1999 by Fujio Okada, Mitsuhsa Nakagawa, and Keiichi Negishi and is owned by the Fuji Photo Optical Co., Ltd. The present application claims priority to Japanese Patent 277321/1998 published on 30 September 1998.

Kazuhiro Yamanaka and Mitsuru Higuchi of the Yamanaka et al. reference are different than Fujio Okada, Mitsuhsa Nakagawa, and Keiichi Negishi of the present application. Furthermore, the effective United States filing date of Yamanaka et al. (11 September 1997) is before the effective United States filing date of the present application (30 September 1998). Therefore, Yamanaka et al. qualifies as prior art under 35 U.S.C. 102(e) because it is a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent. In addition, the Applicant is reminded that commonly owned patents can ALWAYS be used in 35 U.S.C. 102 rejections.

In the Final Office Action (Paper No. 11, 15 January 2004), Claims 3/1 and 3/2 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yamanaka et al. (US 6,078,353). The Applicant claims Yamanaka et al. does not qualify as prior art.

MPEP Section 706.02(I)(1) states:

35 U.S.C. 103 Conditions for patentability; non-obvious subject matter

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination under 37 CFR 1.114 of such an application. >The Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)) did not further amend the exclusion under 35 U.S.C. 103(c) as amended on November 29, 1999.<

The mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application. For reissue applications, the doctrine of recapture may prevent the presentation of claims that were cancelled or amended to overcome such prior art applied in the application which matured into the patent for which reissue is being sought. The recapture doctrine prevents the presentation of claims in reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 35 U.S.C. 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made.

35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103. Subject matter that qualifies as anticipatory prior art under 35 U.S.C. 102, including 35 U.S.C. 102(e), is not affected, and may still be used to reject claims as being anticipated.

As stated above, the effective United States filing date of the present application is 30 September 1998, which is prior to 29 November 1999. Therefore, the amendment to 35 U.S.C. 103(c) does not affect the rejection made by the Examiner.